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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/651,563 08/29/00 WANG

T 210121.478C1

EXAMINER

HM12/0815

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ART UNIT

PAPER NUMBER

1631

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08/15/01

*9*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/651,563

Applicant(s)

Wang et al

Examiner

Michael Borin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 14, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above, claim(s) 1-3, 11-16, and 21-60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 4-10 and 17-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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### **Part III DETAILED ACTION**

Response to restriction requirement filed 6/14/01 is acknowledges. Applicant elected, without traverse, Group III, claims 4-10, 17-20. Claims 1-3, 11-16, 21-60 are withdrawn from consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected groups.

#### ***Further restriction***

Upon further consideration of the restriction requirement made in the previous Office action the following additional restriction of Group I was deemed necessary.

- III.1 Claims 4-10, drawn to polynucleotides encoding polypeptide encoded by polynucleotide of SEQ ID 808, expression vectors and cells comprising the vector, classified in class 536, subclass 23.1 and class 935, subclass 66, and claim 17(in part), drawn to pharmaceutical composition comprising the polynucleotide.
- III.2 Claims 18-20 (in part) drawn to a vaccine comprising polynucleotide of Group I, classified in class 424, subclass 184.1.

Groups III.1 and III.2 are drawn to polynucleotide and its pharmaceutical composition, and to immunogenic composition, respectively. First, as a product, the polynucleotides can be used in a broad variety of other applications (such as expression of peptides or in screening assays). Second, an immunogenic composition may not have any pharmaceutical utility and, therefore, will require

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a separate search as a reference teaching, e.g., antigen-induced production of antibodies, will not necessarily teach pharmaceutical use of the antigen or of a polynucleotide encoding said antigen. Further, if immunogenic composition is a vaccine, it, again, would require different search than pharmaceutical composition. A reference teaching a pharmaceutical will not necessarily teach a composition capable of preventing an immune response. Further, the Groups have different enablement requirements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Mr. Michael Woodward, can be reached at (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

August 13, 2001

mlb

**MICHAEL BORIN, PH.D.**  
**PRIMARY EXAMINER**

